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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,502	02/18/2004	Karen Ann England	240368	2972

7590 12/13/2004
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EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,502

Applicant(s)

ENGLAND ET AL.

Examiner

Steven Wong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-18-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase (3,462,862). Regarding claim 1, Chase discloses a golf ball marker and holder comprising a hat (C), an insert having a base member (10, 11, 13) with a magnetized upper surface and a wing (12) and a marker (14, 16) magnetically attached to the upper surface of the base member.

Regarding claim 2, the base member has a cavity (note Figure 3) and the marker overlies the cavity. Note figure 1 showing space between the shaft (15) of the ball marker and the inner surface of the base member (10). The space will obviously permit the ball marker to teeter.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over England et al. (6,513,165) in view of Chase (3,462,862). Regarding claim 1, England discloses a golf ball marking system comprising an inert having a base member (25) with a magnetized upper surface (33) and a wing (37) and a marker (35) magnetically attached to the base.

However, England lacks the teaching for the system to be applied to a hat.

Art Unit: 3711

It would have been obvious to one of ordinary skill in the art to install the ball marking system of England on the inner surface of a hat with the base member protruding through an opening in the hat as taught by Chase in order to provide another convenient place for carrying the ball marker.

Regarding claim 2, note Figure 3 of England showing the marker overlying the cavity and the marker being teetered to permit its removal.

Regarding claims 3-5, note Figures 3 and 5 showing a discontinuous ring (21) for permitting removal of the ball marker from the base member.

Regarding claim 6, note Figure 3 showing the magnetic upper surface.

Regarding claim 8, the wing (37) extends circumferentially about the base member.

Regarding claims 9 and 10, England teaches for the base member to be stitched to the inner surface (column 3, lines 12-14). It would have been obvious to one of ordinary skill in the art to utilize adhesive to attach the wing to the inner surface in order to firmly secure the system within the hat.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over England et al. (6,513,165) in view of Chase (3,462,862) and Ludwick (3,233,802). Ludwick discloses that it is well known in the art of golf ball markers to provide a magnet that only partially covers the cavity in the base member. Note Figures 3 and 4 showing the magnet (17) extending only partially across the cavity. It would have been obvious to one of ordinary skill in the art to form the tool of England as modified by Chase above with a magnet that only partially extends across the cavity in order to reduce manufacturing costs by reducing the required amount of magnetic material.

Art Unit: 3711

5. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimmick (4,822,052) in view of Chase (3,462,862) and Tate (5,305,999). Regarding claim 1, Dimmick discloses a golf ball marking system comprising a substrate (52) having an inner surface and an outer surface, an insert (58) having a base member (68) that protrudes from the opening in the substrate and a wing (60) that is attached to the inner surface of the substrate and a ball marker (76) attached to the upper surface of the base member.

However, Dimmick lacks the teaching for the marking system to be attached to a hat. Chase teaches that it is well known in the art of ball markers to attach the marker to a hat by inserting part of the system through a hole in the hat. It would have been obvious to one of ordinary skill in the art to replace the substrate of Dimmick with a hat in order to permit the user to carry the ball marker on a hat.

However, Dimmick also lacks the teaching for the base member to be magnetized and the ball marker to be magnetically attached to the base member. Tate reveals a golf accessory including a substrate having a recess (56) for receiving a magnet (52) and a ball maker (14) magnetically attached to the substrate. It would have been obvious to one of ordinary skill in the art to replace the knob and recess (78) of Dimmick with a magnet and magnetic material in order to provide an alternative means for releasably attaching the ball marker to the base member.

Regarding claims 2 and 6, Tate teaches for the base member to comprise a cavity with a magnet that only partially covers the cavity. The ball marker is teetered by the user to remove it from the tool. It would have been obvious to one of ordinary skill in the art to include a magnet that only partially covers the cavity in order to allow the ball marker to be easily removed.

Art Unit: 3711

Regarding claims 3-5, note Figure 5 of Dimmick showing an arcuate ring member (70) with discontinuities.

Regarding claim 8, the wing extends circumferentially about the base member (note element 64 which extends about element 58 in Figure 5 of Dimmick).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dimmick (4,822,052) in view of Chase (3,462,862) and Tate (5,305,999) and Ludwick (3,233,802).

Ludwick discloses that it is well known in the art of golf ball markers to provide a magnet that only partially covers the cavity in the base member. Note Figures 3 and 4 showing the magnet (17) extending only partially across the cavity. It would have been obvious to one of ordinary skill in the art to form the tool of Dimmick as modified by Chase and Tate above with a magnet that only partially extends across the cavity in order to reduce manufacturing costs by reducing the required amount of magnetic material.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dimmick (4,822,052) in view of Chase (3,462,862), Tate (5,305,999) and Tate (6,163,889). Tate '889 reveals a golf ball marking system for a hat including a base member that is adhesively attached and stitched to the hat material. Note Figure 3 showing the stitches (42, 44) and the adhesive (25). It would have been obvious to one of ordinary skill in the art to use adhesive with the wing of Dimmick in order to more securely attach the base member to the substrate.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,462,862) in view of Tate (6,163,889). It would have been obvious to one of ordinary skill in the art to use adhesive on the wing of Chase in order to more securely attach the base member to the substrate.

Art Unit: 3711

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-5, 7 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,820,282 in view of Chase (3,462,862). It would have been obvious to one of ordinary skill in the art to apply the ball marking system of Patent '282 on the inner surface of a hat with the base member protruding through an opening in the hat as taught by Chase in order to provide another convenient place for carrying the ball marker.

11. Claims 6, 9 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,820,282 in view of Chase (3,462,862) and England et al. (6,513,165). It would have been obvious to one of ordinary skill in the art to replace the magnet (33) of Patent '282 with the magnet taught by England ('165) in order to provide a stronger attraction between the marker and the base member. Further, it would have been obvious to one of ordinary skill in the art to use stitching or adhesive to attach the base member to the inner surface in order to firmly secure the system to the hat.

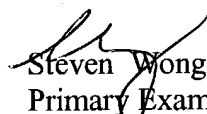
Art Unit: 3711

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
December 9, 2004